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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,249	03/13/2001	Masaaki Mori	1095.1171/JDH	9135
21171	7590	09/03/2008		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER BARQADLE, YASIN M	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 09/03/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/804,249

**Applicant(s)**

MORI ET AL.

**Examiner**

YASIN M. BARQADLE

**Art Unit**

2153

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-7 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/IC)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **Response to Amendment**

The amendment filed on June 26, 2008 has been fully considered but are moot in view of the new grounds of rejection.

- Claims 1, 3-6 and 15 are presented for examination.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. “ storing, in advance by a recipient of the electronic mail...” as in claims 1 and 5 or “the transfer management information being registered in advance with a memory by a recipient of the electronic mail...” as in claim 6. The specification does not specify clearly the above limitations. It does not clearly described how storing is done in advance by a recipient of the electronic mail...”

Claims 1 3-6 and 15 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with idiomatic phrases such "in the case of..." for example in claim 1 line 3, 9 and claim 5, lines 4 and 11. Same thing is true for claim 6.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example it is not clear what is the "log-in account adding means for adding a user account to the internal server and a password of the account of the internal server, to the

electronic mail by referring to the transfer management information.” It is clear why the sender add a user account and a password. It is not clear in the specification or in the claims the step of “log-in account adding means for adding a user account to the internal server and a password of the account of the internal server, to the electronic mail by referring to the transfer management information.” There are too many accounts and password which makes hard to follow and examine properly. For example, there is a user account and password of the external server. There is referring to transfer management information of internal server with user account and password.. There is the adding step of the user account of the internal server and the password of the account of the internal server, to the email. (it is not clear why? According to specification the sender adds username and the password.

It is suggested that Applicant’s representative to schedule for interview to discuss the invention as claimed and to advance the prosecution of the application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an

international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3-6 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsai US. Patent No. (6839741).

In referring to claim 3, Tsai shows,

Not only store location information but also transfer method information indicating a transfer method used by the attached file transferring means are added to the electronic mail:  
(col. 4, lines 14-26 and col. 5, lines 16-25).

In referring to claim 4, shows,

The attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an

electronic mail server: Tsai, Figure 4 and 5 shows the attached file separating means, attached file transferring means, and store location information adding means are implemented ms exit programs on an electronic mail server)

As per claim 1, 5 and 6, Tsai teaches an electronic mail system for delivering electronic mail sent from a sender to the appropriate receiver (fig. 5 and abstract), the system comprising:

attached file retrieving means for retrieving, in the case of a store location information of an external server, a user account of the external server, and a password of the user account of the external server being added to electronic mail sent from the sender (col. 4, lines 39-60 fig. 3A and fig. 5);

an attached file from the external server of location shown by the store location information of the external server using the user account of the external server and the password of the external server, the external server being connected outside of a network protected from outside (col. 4, lines 39-60 and col. 5, lines 20-25. See fig. 5 external server 30); attached file separating means for separating, in the case of the attached file being added to the electronic mail sent from the sender, the attached file from the electronic mail (col. 3, lines 11-22); transfer management information removing means for removing the store location information of the external server, the user account of the external server, and the password of the external server from the electronic mail (col. 6, lines 11-

34); transfer management information storing means storing, in advance by a user, the transfer management information including a store location information of an internal server, a user account of the internal server, and a password of the account of the internal server, the internal server being connected inside of the network (col. 5, lines 26-54 and fig. 5);

log-in account adding means for adding a second user account of the internal server and a password of the account of the internal server, to the electronic mail by referring to the transfer management information (col. 5, lines 26-54 and fig. 3A and 3B recipient of the internal LAN accesses attached files using his login credentials such as user id and password);

attached file transferring means for transferring the attached file separated from the electronic mail by the attached file separating means or retrieved from the external server by the attached file retrieving means to the internal server using the user account of the internal server and the password of the account of the internal server by referring to the transfer management information, to enable a user to refer to the attached file transferred by logging in at the internal server (col. 6, lines 44-67 and col. 4, lines 51-63 recipient accesses the attachment file based on access right and credentials provided in the notification); and

store location information adding means for adding store location information indicating a location where the attached file transferred by the



attached file transferring means is stored to the electronic mail (col. 4, lines 51-63).

Regarding claim 15, this is a method claim with similar limitations as claims 1, 5 and 6 above. Therefore it rejected with the same rationale.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YASIN M. BARQADLE whose telephone number is (571)272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yasin M Barqadle/  
Primary Examiner, Art Unit 2153